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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/327,408	06/07/1999	PATRICK M. COX	8897-0046-99	5392

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EXAMINER

KNOWLIN, THUAN P

ART UNIT PAPER NUMBER

2642

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/327,408	<b>Applicant(s)</b> COX ET AL.	
	<b>Examiner</b> Thjuan P Knowlin	<b>Art Unit</b> 2642	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 158-201 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 158-171 is/are allowed.
- 6) ☒ Claim(s) 172-201 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Allowable Subject Matter*

2. Claims 158-171 are allowed.
3. The following is an examiner's statement of reasons for allowance: In regards to claim 158, a method of providing directory assistance to a caller comprising: determining if a predefined condition relating to the status of the telephone call occurs, if the predefined condition occurs, obtaining an identifier of a messaging device associated with the desired party for contacting the desired party, the identifier being different from the destination telephone number, sending a message to the messaging device associated with the desired party based on the identifier, and allowing the caller to obtain the identifier of the messaging device from a directory assistance provider, is not taught, nor made fairly obvious by any prior art. No prior art was found that discloses or teaches the limitations of claim 158.
4. Claims 159-171 are dependent upon claim 158, therefore, claims 159-171 are allowed.
5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 172-183, 192-195, and 197-201 are rejected under 102(e) as being anticipated by Yablon (US 5,764,731).
7. In regards to claims 172, 174, 175, 192, 194, 195, and 197, Yablon discloses a method of providing directory assistance services (Abstract), comprising: receiving a call from a caller (Fig. 5), the call including a request for directory assistance; in response to the request, locating contact information associated with a desired party; establishing a communication between the caller and the desired party based on the contact information; determining whether the caller has a device capable of receiving a message (col. 8 lines 5-13, col. 14 lines 47-67, col. 25-26 lines 42-5; and sending a message containing at least part of the contact information to the device when it is determined that the caller has the device capable of receiving a message (Abstract, col. 9-10 lines 59-15, and col. 17-18 lines 54-6).

8. In regards to claim 173, Yablon discloses the method, wherein the call originates from a telephonic apparatus having a telephone number associated with the caller (col. 6 lines 5-10).
9. In regards to claims 176 and 200, Yablon discloses the method, wherein the message comprises a text message (col. 17 lines 54-63).
10. In regards to claims 177 and 193, Yablon discloses the method, wherein the contact information comprises a telephone number associated with the desired party (col. 6 lines 5-10).
11. In regards to claim 178, Yablon discloses the method, wherein the contact information comprises a name of the desired party (col. 4 lines 53-58).
12. In regards to claim 179, Yablon discloses the method, wherein the communication comprises a telephone call (Abstract).
13. In regards to claims 180 and 201, Yablon discloses the method, wherein the message comprises a page (col. 5 lines 35-39).
14. In regards to claim 181, Yablon discloses the method, wherein the device comprises a pager (col. 5 lines 35-39).
15. In regards to claim 182, Yablon discloses the method, wherein the device comprises a PCS device (Abstract, Fig. 4, and Fig. 5).
16. In regards to claim 183, Yablon discloses the method, wherein the device comprises a wireless telephone (Abstract, Fig. 4, and Fig. 5).
17. In regards to claims 198 and 199, Yablon discloses the method, wherein said contact information is audibly provided to said caller (col. 17 lines 54-63).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 184-191 and 196 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablon (US 5,764,731), in view of Greenspan (US 5,590,187).

19. In regards to claims 184 and 189, Yablon discloses all of claim 184 limitations except, a method of providing directory assistance services by a directory assistance provider, comprising: upon completion of said call, allowing the caller to return to a directory assistance provider by issuing a command. Greenspan, however, does disclose a method of providing directory assistance services by a directory assistance provider (transferring station), comprising: upon completion of said call, allowing the caller to return to a directory assistance provider by issuing a command (Abstract and col. 6 lines 56-64). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to employ this feature into the method as a way of transferring a caller back to the operator/transferring station, in order to obtain further information or instruction as to how to proceed with his or her call attempt, without having to go through the entire process again with a new operator/transferring station.

20. Yablon discloses all of claim 185 limitations except, the method, wherein said command comprises a DTMF tone. Greenspan, however, does disclose the method, wherein said command comprises a DTMF tone (Abstract).
21. In regards to claims 186 and 190, Yablon discloses the method wherein the alphanumeric message comprises a telephone number of said desired party (col. 6 lines 5-10).
22. In regards to claims 187 and 191, Yablon discloses the method, wherein said alphanumeric message comprises a name of said desired party (col. 4 lines 53-58).
23. In regards to claim 188, Yablon discloses the method, wherein said alphanumeric message is sent to the caller automatically upon completion of said call (Abstract).
24. Yablon discloses all of claim 196 limitations except, the method, wherein said predefined condition comprises a busy signal. Greenspan, however, does disclose the method, wherein said predefined condition comprises a busy signal (Abstract).

### ***Response to Arguments***

25. Applicant's arguments with respect to claims 158-201 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Riskin (US 5,031,206) teaches a method and apparatus for


identifying words entered on DTMF pushbuttons. Boivie et al (US 4,633,041) teach a station set directory assistance arrangement.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan P Knowlin whose telephone number is (703) 308-1727. The examiner can normally be reached on Mon-Fri 8:00-4:30pm.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703)305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thjuan P. Knowlin



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